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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/660,685

09/12/2003

Jose Vicente Barbera Alacreu

2644-0105P

7699

2292 7590 09/03/2009  
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EXAMINER

BUI, VY Q

ART UNIT

PAPER NUMBER

3773

NOTIFICATION DATE

DELIVERY MODE

09/03/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

## Office Action Summary

**Application No.**

10/660,685

**Applicant(s)**

BARBERA ALACREU, JOSE VICENTE

**Examiner**

Vy Q. Bui

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-41 is/are pending in the application.
- 4a) Of the above claim(s) 23-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/12/2003</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Election/Restrictions***

Applicant's election of invention as shown in F. 22, 24 and 26 and claims 22, 38-41 for further examination with traverse of the restriction requirements in the reply filed on 4/8/2009 and 7/30/2008 are acknowledged. Claims 23-37 have been withdrawn from further consideration as claims of non-elected inventions.

A fair reading of the election of the Applicant indicates that the Applicant considered species of hooks 115, 118 shown in Figs. 22, 24 and 26 are equivalent or not patentable distinct. Further, claims 22, 38-41 read on hook 115 as shown in Fig. 26.

As such, the examination will focus on a claimed combination of rod 112, hook 115 as vertebral fixation device and elements 118 as connectors/couplings as shown in Fig. 26.

The traversal is on the ground(s) that the restrictions were improper. This is not convincing for the reasons as follows.

1. In the reply filed on 7/30/2008, the Applicant elected the inventions as shown in F. 19-26 and contended that F. 19-24 are not mutually exclusive (last paragraph of page 2 and 1<sup>st</sup> paragraph of page 3, paper 7/30/2008).

This is not found persuasive because as admitted by the Applicant (paper 7/30/2008, page 3, 3<sup>rd</sup> paragraph), pedicle hook 115 having concave finger 132 (F. 22), lamina hook 115 having finger 121 (F. 24) and hook 118 having set screw 119 and locknut 120 (F. 26) are mutually exclusive species and Applicant indicated that a restriction between these species would be acceptable. Further, as admitted by the Applicant (paper 7/30/2008, page 3, last

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paragraph to page 4, 1<sup>st</sup> paragraph), there are different open swivels shown in F. 23, F. 26 and Applicant also indicated that a restriction between these species would be acceptable.

Applicant's arguments above were convincing, therefore, to save time and to accelerate the prosecution of the present invention, the Examiner did not argue further but issued another restriction (paper 10/31/2008) to restrict between different sub-species of hooks as shown in Figs. 22, 24, 26 and different sub-species of open swivel as shown in Figs. 23, 26 as the Applicant had correctly identified in paper 7/30/2008.

2. In the reply filed on 4/08/2009, the Applicant elected the inventions as shown in F. 22, 24 and 26 and claims 22, 38-41 for further examination with traverse (paper 4/8/2009, page 11, paragraph before last paragraph).

The Applicant (paper 4/8/2009) traversed on the ground that: "The Examiner has to examine the claimed invention, and cannot redefine the invention, as has been done here, so that the Examiner can limit what has to be searched and examined. In the prosecution of this Application, file Examiner has improperly ignored the claimed combination invention, and has chosen to try to limit examination to what is not claimed. Applicants have not claimed pedicle hooks, *per se*, and have not claimed swivels, *per se*, but have claimed the aforementioned combinations and if the Examiner wants to restrict between independent and distinct inventions, any restriction requirement must be based on the claimed invention, which is a combination invention, and not element of file claimed combination invention such as, for example, some hook invention, *per se*, or swivel invention, *per se*."

This is not found persuasive because it is very clear that the present application includes more than one distinct inventions (for example, expansion screw as shown in F 19, different

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couplings/connectors 11 as shown in Figs. 21 and 26, different hooks as shown in Figs. 22, 24 and 26) and the Applicant always can put more claims for each of these species or sub-species or element any time during a prosecution of the present invention. Each element of the system of the present invention is indeed can be considered as an invention and required different extensive prior art search of hundreds or thousands of references for determination of the patentability for each element. The time for prosecution for one invention is strictly controlled by the Office and it is very clear that it is impossible for the Examiner to conduct various searches to cover different elements as disclosed in the present application.

The prosecution of one application is a very serious matter to the Applicant and the public. A valid patent requires a lot of time and effort from both the Applicant and the Office. The Examiner is trying to rely on the Applicant for pointing out to the Office an inventive feature and limit the prosecution of the present application to only a limit number of species or sub-species or elements disclosed in the present invention so that both the Examiner and the Applicant can fully focus on during the prosecution of the present invention. If there is no agreement from the beginning between the Applicant and the Examiner about what species or sub-species or elements should be focus on during the prosecution, the prosecution will be lengthened forever when the Applicant claim other species or sub-species or elements after one species/sub-species/element has been found not inventive and rejected by a prior art reference. This is completely counter-productive to both the Applicant and the Office.

In addition, when the prosecution of this application takes too much more time than time allowed by the Office, the Examiner will fail to meet the production goal pre-determined by the Office and face severe disciplinary action including termination.

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The Examiner sincerely hopes that the Applicant will not spend more time to argue about the restrictions and will spend more time to work with the Examiner to find a valid allowable subject matter and accelerate the prosecution of the present application.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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1. Claim 22 is rejected under 35 U.S.C. 102(b) as being anticipated by Brumfield et al-5,562,662.

As to claim 22, Brumfield-'662 (F. 11) discloses connector/coupling 29, rod 21 and vertebral fixation elements (including hook 25, threaded stem 26) and locknut 124 substantially as recited in the claim.

2. Claims 38-39, 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Brumfield et al-5,562,662.

As to claims 38-39 and 41, Brumfield-'662 (F. 7, 8a, 8b and 10) discloses connector or coupling 120/120', rod 200, vertebral fixation elements (including hook 104, tail 102) and locknut 150 substantially as recited in the claims. Notice that hook 104 can be screwed and pushed simultaneously into connector or coupling 120/120' as recited in claims 38 and 39.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brumfield et al-5,562,662.

As to claim 40, Brumfield-'662 (F 8a, 8b) discloses connector or coupling 120 having internal threads 132 (F 8a) for a set screw to lock rod 200 and connector or coupling 120' (F 10) having external threads 132' for a locknut 150 to lock rod 200.

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F 10 of Brumfield-'662 appears to show both setscrew and locknut 150 to lock rod 200. However, Brumfield-'662 does not explicitly express both setscrew and locknut to lock rod 200. It would have been obvious to one of ordinary skill in the art to provide a setscrew to lock rod 200 in connector or coupling 120 as shown in F 8a and provide a locknut to keep upper legs 122 from any outwardly deformation of as taught by F 8b, as this will prevent any gradual releasing of rod 200 from connector or coupling 120 as shown in F 10 from time to time.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vy Q. Bui whose telephone number is 571-272-4692. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on 571-272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vy Q. Bui/

Primary Examiner, Art Unit 3773